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08/915,658	08/21/1997	JIGISH D TRIVEDI	MIO 0024 PA/40509.49	1803

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DINSMORE & SHOHL LLP
ONE DAYTON CENTRE, ONE SOUTH MAIN STREET
SUITE 1300
DAYTON, OH 45402-2023

EXAMINER	
PHAM, LONG	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 08/915,658

Filing Date: August 21, 1997

Appellant(s): TRIVEDI, JIGISH D

Susan Luna

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/06/05 appealing from the Office action mailed 04/04/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Appeal No. 2002-0043.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,094,981	Chung et al.	03-92

4,910,578 Okamoto 03-90

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

See the contents of the final rejection dated 04/04/05.

(10) Response to Argument

In response to the appellant's arguments in the paragraphs on pages 5, 6, 7, and 8 and the paragraph bridging pages 9 and 10 of the Brief on Appeal dated 09/06/05, it is submitted that Chung et al. teach a composite structure comprising of a first metal silicide or titanium silicide 38A,38B (see col. 5, lines 20-22), a second metal silicide or tungsten silicide 40A, 40B (see col. 5, lines 60-65 and col. 7, lines 53-60) and an intermetallic compound 36A,36B comprises of metal of titanium from the first metal silicide and metal of tungsten from the second metal silicide (see col. 4, lines 55-60). Further, since claimed invention is directed to a structure it is submitted how the composite structure is formed has not been given patentable weight. Further, it is submitted:

A comparison of the recited process with the prior art process does not serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 uspq 324 (CCPA 1974).

Where a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which is made is patentable. In re Klug, 333 F2d 905, 142 uspq (CCPA 1964).

In an exparte case, product by process claims are not constructed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 uspq 15, see footnote 3 (CCPA 1976).

"Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product

of the prior art, the claim is unpatentable even though the prior product was made by a different process.". In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., In re Garnero, 412 F.2d 276, 279, 162USPQ 221, 223 (CCPA 1979).

In response to appellant's arguments in the paragraph bridging pages 8 and 9 of the Brief on Appeal dated 09/06/05, it is submitted that the appellant has the burden of proving the criticality of the claimed range. See MPEP 2144.05.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Long Pham

Conferees:

Wael Fahmy

Ricky Mack

Long Pham